

REMARKS

In response to the above-identified Office Action, Applicants amend the application and seek reconsideration thereof. In this response, Applicants amend claims 1, 9, 26 and 33. Applicants do not cancel any claims. Applicants add new claims 41-48. Accordingly, claims 1-48 are pending.

I. Objections to the Drawings

The drawings stand objected to under 37 C.F.R. 1.83(a).

Applicants note that 37 C.F.R. 1.83(a) requires that every feature of the invention specified in the claims be shown. However, 37 C.F.R. 1.83(a) also states that "conventional features disclosed in the description and claims, where the detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or label representation (e.g., a labeled rectangular box)." The Examiner states that "a user presented with first and second scripts, controlling modes, or an examples of showing by displaying first and second scripts for user input, the claimed registers and the table of register values" are not shown. The Examiner also states that the method of claim 15 is not illustrated. In regard to the list of elements provided by the Examiner relating to switching of control modes, Applicants submit herewith an amended Figure 8A and Figure 8B. Entry is requested. Applicants note the amended claims show processing of user inputs and execution of scripts that change control node. In regard to Figures 7A and 7B, these figures already show use of a register (GPRM) in block 710 and locating the address in block 712. In regard to the elements of claim 15, Applicants believe that amended Figures 8A and 8B in combination with Figures 7A and 7B illustrate each of the elements of claim 15 in accordance with 37 C.F.R. 1.83(a). Accordingly, reconsideration and withdrawal of the objection to the drawings are requested.

II. Claims Rejected Under 35 U.S.C. § 102

Claims 1, 2, 5-9, 11, 17, 20, 21, 26, 27, 30-33 and 35 stand rejected under 35 U.S.C. § 102(e), as anticipated by U.S. Patent No. 5,982,445 issued to Eyer, et al. (hereinafter "Eyer").

To anticipate a claim, each element of the claim must be taught by a single reference. In regard to independent claims 1, 17, 26 and 33 these claims include the elements of "controlling a device in a first mode that executes a first process in a first operating environment" and "changing control of the device from the first mode to a second mode . . . , the second mode to execute a second process in a second operating environment" (claims 1 and 26), "processing user input in a first operating environment" and "processing input from a second operating environment" (claims 9 and 33) or "a processor to execute a first process in a first operating environment and a second process in a second environment . . . the script to change control to the second process" (claim 17). Applicants believe that Eyer does not teach these elements of claims 1, 9, 17, 26 and 33. Specifically, Eyer does not teach a script executed as part of a markup language page that causes a switch from a processing of the user input in a first operating environment to a processing of user input in a second operating environment. On Page 4 of the Office Action, the Examiner cites col. 7 and the use of a CGI script to handle user inputs to teach "displaying a first markup language page that includes a first script and changing control of the device from a first mode to a second mode upon execution of the first script." Applicants reviewed the cited section of Eyer but have been unable to discern any part therein that teaches how the execution of a CGI script alters the operating environment that processes user input for the device. Rather, the cited section of Eyer teaches the use of a an HTML form where the form may designate a CGI script to process the information input in a form. This use of a CGI script does not alter an operating environment that handles user input for the device. Thus, Applicants believe that Eyer does not teach each of the elements of claims 1, 9, 17, 26 and 33. Accordingly, reconsideration and withdrawal of the anticipation rejection of claims 1, 9, 17, 26 and 33 are requested.

In regard to claims 2, 5-8, 11, 20, 21, 27, 30-32 and 35, these claims depend from independent claims 1 and 9 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to independent claims 1, 9, 16, 26 and 33, Eyer does not teach each of the elements of these claims. Accordingly, reconsideration and withdrawal of the anticipation rejection of these claims are requested.

III. Claims Rejected Under 35 U.S.C. § 103

Claims 3, 4, 10, 18, 28, 29 and 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Eyer.

To establish a *prima facie* case of obviousness, the Examiner must show that the cited references teach or suggest each of elements of the claims. In regard to claims 3, 4, 10, 18, 28, 29 and 34, these claims depend from independent claims 1, 9, 17, 26 and 33 and incorporate the limitations thereof. Thus, for the reasons mentioned above in regard to the independent claims, Eyer does not teach or suggest each of the elements of these claims. Specifically, Eyer does not teach or suggest the execution of a script that switches the operating environment. Accordingly, reconsideration and withdrawal of the obviousness rejection of these claims are requested.

Claims 12-14, 15, 16, 19, 22-25 and 36-40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Eyer in view of U.S. Patent Application No. 2002/0007493 applied for by Butler, et al. (hereinafter "Butler").

In regard to claims 12, 19 and 36, these claims depend from independent claims 9, 17 and 33, respectively. Thus, for the reasons discussed above in regard to the anticipation rejections of independent claims 9, 26 and 33, Eyer does not teach or suggest each of the elements of these claims. The Examiner has not indicated and Applicants have been unable to discern any part of Butler that teaches a script that changes the operating environment. Accordingly, reconsideration and withdrawal of the obviousness rejection of these claims are requested.

In regard to independent claims 13, 15, 22 and 37, these claims include the elements of video content provided by a DVD or a multimedia drive. The Examiner admits on page 8, Eyer does not teach these elements of the independent claims. These claims further include the elements of setting a register value in a DVD or multimedia drive. The Examiner relies on Official Notice to teach the elements of using a register. Applicants respectfully traverse this taking of Official Notice. Applicants request that the Examiner substantiate this assertion. Specifically, the Applicants request that the Examiner substantial the assertion that it is known to use a register of a multimedia device as a means for synchronizing the combination video content from the DVD and

media drive with overlay information. The Examiner relies on Butler for teaching use of a DVD. The Examiner argues that "it would have been obvious to one skilled in the art . . . that the stream can be generated from the DVD, wherein the recited setting a register is the corresponding tracking of the time duration of playing, wherein overlaying would be accomplished based on the comparison of the time information, with the timing information of the DVD stream register or time code corresponding to the playing time or duration of playing, thereby triggering an overlay wherein the user can interact where the overlay is presented." However, the Examiner has not set forth how the cited references teach the desirability of the modification of the primary reference to utilize a DVD or multimedia drive as a source of video content. See MPEP § 2143.01, Section titled "The Prior Art Must Suggest the Desirability of the Claimed Invention." Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so either explicitly or implicitly in the references themselves or in knowledge generally available to one of ordinary skill in the art. A discussion is set forth by the Examiner on page 9 that one of ordinary skill in the art when presented with the prior art references *could* combine them to read on the limitations of the claims. This is insufficient to establish a *prima facie* case of obviousness. See MPEP § 2143.01, entitled "Fact that References Can be Combined or Modified is Not Sufficient to Establish *Prima Facie* Obviousness." Therefore, the Examiner has failed to establish *prima facie* case of obviousness for these claims. Accordingly, reconsideration and withdrawal of the obviousness rejection of claims 13, 15, 22 and 37 are requested.

In regard to claims 14, 16, 23-25 and 38-40, these claims depend from independent claims 13, 15, 22 and 37 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to independent claims 15, 22 and 37, these claims are not *prima facie* obvious over Ever in view of Butler. Accordingly, reconsideration and withdrawal of the obviousness rejection of these claims are requested.

IV. New Claims

New claims 41-48 depend from independent claims 1, 13, 17 and 22 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to the independent claims, Applicants believe the new claims are in condition for allowance.

CONCLUSION

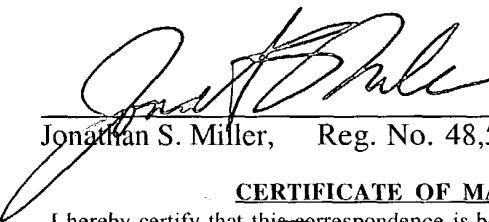
In view of the foregoing, it is believed that all claims now pending, namely claims 1-48 patentably define the subject invention over the prior art of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (310) 207 3800.

Respectfully submitted,

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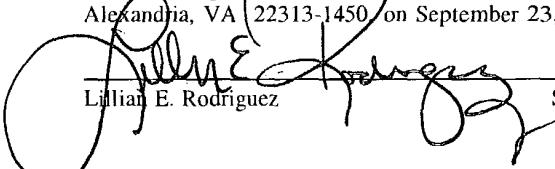
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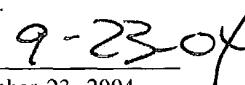
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Lillian E. Rodriguez


September 23, 2004